

Applicants: Berner et al.  
Application Serial No.: 10/534,443  
Filing Date: May 10, 2005  
Docket No.: 442-241 PCT/US  
Reply to Non-Final Office Action mailed August 8, 2006  
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### **REMARKS**

Pursuant to the non-final Office Action mailed August 8, 2006, Applicants request reconsideration. To further prosecution of this application, each of the issues raised in the Office Action is addressed herein.

Claims 1-18 are currently pending in this application, of which Claims 1 and 11 are independent claims. By this Amendment, Claim 11 has been amended to accept subject matter deemed allowable by the Examiner. The application as now presented is believed to be in allowable condition.

#### **A. Allowable Subject Matter**

Applicants note with appreciation that at page 3 of the Office Action, Claims 11-13 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims. Accordingly, while not acceding to the propriety of any claim rejections over prior art set forth in the Office Action, Applicants have rewritten Claim 11 to accept subject matter deemed allowable by the Examiner so as to expedite prosecution of this application toward allowance.

Specifically, dependent Claim 11, which was indicated as conditionally allowable, has been rewritten to incorporate the subject matter of independent Claim 1. Thus, Claims 11-13 are in condition for allowance.

#### **B. Claim Rejections under 35 U.S.C. §102**

Claims 1-10 and 14-18 were rejected as being anticipated by DE 29909529.

The present invention is directed to a fluid power controller device, which includes valve modules arranged in sequence in a row direction and collected together as an array-like unit. The modules include a principal valve fitted with at least one moving valve member

and at least one electrically operated valve drive for the principal valve. At least two valve modules are placed in sequence in the row direction and spaced apart with the formation of an intermediate space. A diagnostic module is placed in the intermediate space for the detection of at least one operational state of one or both of the adjacent principal valves, as now defined by amended Claim 1.

A copy of European Patent No. 1 059 458, which corresponds the '529 reference, and an English translation of the '458 European Patent is submitted herewith. Page 6, paragraph 3 of the '529 reference corresponds to paragraph [0020] of the '458 patent and to page 4, paragraph 4 of the English translation. Page 10, paragraph 2 of the '529 reference corresponds to paragraph [0032] of the '458 patent and to page 6, paragraph 4 of the English translation.

It is submitted that the '529 reference merely refers to electronic modules, but does not teach or fairly suggest a diagnostic module placed in an intermediate space between two valve modules for the detection of at least one operational state of one or both adjacent principal valves, as defined by Claim 1. A feature of the subject invention is that a controller device, which is equipped with a plurality of valve modules, is additionally equipped with at least one diagnostic module placed between two valve modules, wherein the diagnostic module does not only serve to control the fluid supply of the controller device, but is also able to detect at least one operational state of one or both adjacent principal valves.

The '529 reference describes a control unit with a plurality of individual devices, most of which are valve devices. The valve devices are supplied with fluid from a central passage 25 (page 6, paragraph 3 of the English translation) that penetrates the individual devices. An electronic device 7 is positioned between valve devices that (according to page 6, last paragraph 4 of the English translation) may be penetrated by the central passage 25. As further indicated in the '529 reference, the fluid flowing through central passage 25 simply

passes through the electronic device 7 without being measured in any way, and thus the fluid passage in the electronic device 7 is simply a through-passage.

However, the electronic device described in the '529 reference does not detect the operational state of one or both of the adjacent valve modules, as defined by Claim 1. That is, the electronic device in the '529 reference is not designed to detect whether one or both of the principal valves of the adjacent valve devices are operating correctly. In contrast, the claimed invention is able to detect whether one or both adjacent principal valves is malfunctioning.

From the English translation, it is clear that the '529 reference merely discloses the use of electronic modules 7 between valve modules that are stacked in series. Therefore, nothing in the '529 reference would teach or suggest a fluid power controller device, in which a diagnostic module is placed in an intermediate space between at least two valve modules to detect at least one operational state of one or both of the adjacent principle valves, as defined by Claim 1.

C. Claim Rejections under 35 U.S.C. §103

Claims 1-10 and 14-18 were also rejected as being obvious in view of the '529 reference and U.S. Patent No. 6,213,153 to Hayashi et al. (*Hayashi*).

The remarks made above with respect to the '529 reference are applicable to the rejection under 35 U.S.C. §103. Further, it is submitted that nothing in *Hayashi* would teach or fairly suggest placing a diagnostic module in an intermediate space between at least two valve modules to detect at least one operational state of one or both of the adjacent principle valves, as defined by Claim 1. Rather, *Hayashi* describes only the placement of an electronic circuit section 31 at the end of a solenoid valve manifold, as shown in Figure 1, with no mention of diagnostic functions performed by the electronic circuit section 31.

Applicants respectfully note that in order to support a claim of *prima facie* anticipation, a single reference must teach or enable each of the claimed elements as arranged

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in the claim interpreted by one of ordinary skill in the art. Further, in order to support a claim of *prima facie* obviousness, the cited references must teach or suggest each and every element of the invention, and there must be a motivation in the references or the prior art to combine the references and the prior art as suggested.

However, nothing in the art of record would teach or suggest, either alone or in combination, a fluid power controller device, which includes valve modules arranged in sequence in a row direction, wherein at least two valve modules are placed in sequence in the row direction and spaced apart with the formation of an intermediate space, and wherein a diagnostic module is placed in the intermediate space for the detection of at least one operational state of one or both of the adjacent principal valves, as now defined by Claim 1.

It is to be noted that a Notice of Allowance (Communication according to Rule 51(4) EPC) has been received concerning the corresponding European patent application in response to the remarks submitted above.

Applicants respectfully submit that Claims 2-10 and 14-18, which ultimately depend from Claim 1, are patentable over the art of record by virtue of their dependence from Claim 1. Further, Applicants submit that Claims 2-10 and 14-18 define additional patentable subject matter in their own right. Therefore, it is respectfully requested that the rejection of Claims 1-10 and 14-18 under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) be reconsidered and withdrawn.

#### Conclusion

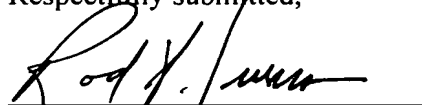
Entry of the amendments to Claim 1; favorable consideration of Claim 1, as amended; and allowance of pending Claims 1-18 are solicited.

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the

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Examiner is requested to call the Applicants' attorney at the telephone number provided below to discuss any outstanding issues relating to the allowability of the application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Rod S. Turner", is written over a horizontal line.

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